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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,869	08/23/2001	Jose Garcia Arumi	ARUMI	9449
7590 11/16/2004				
Ursula B. Day 350 Fifth Avenue, Suite 3220 New York, NY 10118				
			EXAMINER BAXTER, JESSICA R	
			ART UNIT 3731	PAPER NUMBER
DATE MAILED: 11/16/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/935,869

Applicant(s)

ARUMI ET AL.

Examiner

Jessica R Baxter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-11, 15, 16 and 21 is/are rejected.
- 7) ☒ Claim(s) 8, 12, 13 and 17-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Newly submitted claim 22 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claim 21 claims a cutting instrument, whereas claims 1-21 claim a grasping/holding instrument.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 21 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 7, 9, 10, 11, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent no. 5,222,973 to Sharpe et al.

Regarding claims 1, 7, 15 and 16, Sharpe discloses an instrument comprising a housing configured as a handle (14) and a functional unit disposed thereon and an actuator supported within the housing in operative engagement with a sliding pin and connected with the functional unit (12); and a tube shaped probe (11), which extends into a head piece and is movable in an axial direction relative thereto for operative engagement with the functional

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unit (12); and a rod co-axially supported within the probe configured as a grasping element (12) and having two arms separated by a slot (FIG. 3), the two arms are configured with distal end portions which are substantially transverse to the longitudinal axis and delimiting a recess opposing one another and are movable relative to one another into an elastic pre-tensioning first position wherein both arms are spread apart (FIG. 2) and a second position wherein the end portions terminate into opposing end faces (FIG. 3). Which when both arms are pressed together form a flush closure such that the two opposing recesses are formed together into a common recess for freely retaining and holding micro structures without squeezing or pinching the microstructures (Column 3 lines 22-29), and wherein the two arms starting from the cylindrical rod in the direction of the frontal face of the head piece are tapered off with opposing outside walls of the taper configured in one of a straight or arcuate shape (FIG. 3).

Regarding claim 9, Sharpe discloses that the recess of each of the arms starting from a frontal leg thereof in direction of the slot is arcuately shaped such that in a closed position the common recess has the shape of a tear drop (FIG. 3).

Regarding claim 10, Sharpe discloses that an inside length of the tear drop shaped recess is greater than the inside width of the tear drop shape (FIG. 3).

Regarding claim 11, Sharpe discloses that the recess of each of the arms each starting from a frontal leg thereof in axial direction of the slot is arcuately shaped such that in a closed position the common recess has an elongated shape (FIG. 3).

4. Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,486,185 to Freitas et al.

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Freitas discloses an instrument comprising a housing configured as a handle and a functional unit disposed thereon and an actuator supported within the housing in operative engagement with a sliding pin (108) and connected with the functional unit (FIG. 8); and a tube shaped probe (112) connected with the actuator and movable in axial direction relative to a head piece for operative engagement with the functional unit; and - a rod (104) extending into the head piece is co-axially supported within the probe and secured against axial displacement, wherein the head piece is configured as a grasping element and having two arms separated by a slot (FIG. 8), the two arms are configured with distal end portions which are substantially transverse to the longitudinal axis and delimiting a recess opposing one another and are movable relative to one another into an elastic pre-tensioning first position wherein both arms are spread apart and a second position wherein the end portions terminate into opposing end faces (FIG. 2), which when both arms are pressed together form a flush closure such that the two opposing recesses are formed together into a common recess, and wherein the two arms starting from the cylindrical rod in direction of the frontal face of the head piece are tapered off with opposing outside walls of the taper configured in a straight shape.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sharpe et al. '973 in view of U.S. Patent No. 5,746,770 to Zeitels et al.

Sharpe discloses the claimed invention except for the light guide projecting from the probe and configured as an optical lens. Zeitels teaches that a light guide is provided in a grasping instrument in order to directly illuminate the area in which the surgeon is working (Column 2 line 66-Column 2 line 25 and Column 4 line 53-Column 4 line 9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Sharpe with the light guide of Zeitels in order to directly illuminate the surgical site.

Allowable Subject Matter

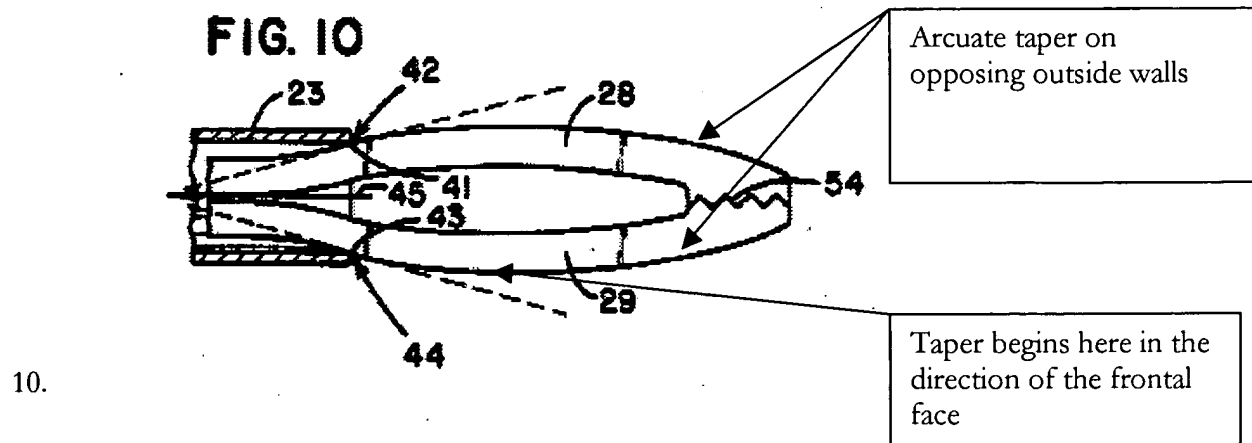
7. Claim 8, 12, 13, 14 and 17-20 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed August 16th 2004 have been fully considered but they are not persuasive.

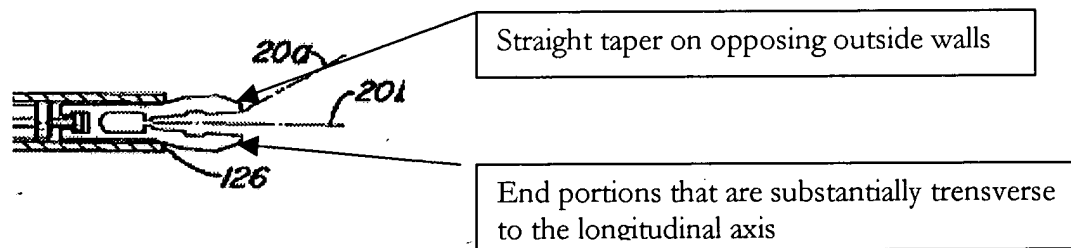
9. Applicant argues that the device disclosed by Sharpe et al. '973 does not disclose tapering arms as claimed by applicant. Applicant claims, "wherein the two arms starting from the cylindrical rod in the direction of the frontal face of the head piece when laterally viewed are tapered off with opposing outside walls of the taper configured in one of a straight or arcuate shape." The attached figure 10, clearly indicates how this claim limitation is met.

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10.

11. Applicant argues that Freitas et al. '185 does not disclose distal end portions that are substantially transverse to the longitudinal axis and the tapering of the arms as claimed by applicant. In Figure 4, Freitas shows the opposing outside walls with a straight taper and distal end portions that are substantially transverse to the longitudinal axis.



12. In response to applicant's argument that the light guide of Zeitels et al. '770 could not be incorporated into the device of Sharpe et al. '973, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica R Baxter whose telephone number is 571-272-4691. The examiner can normally be reached on M-F 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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arb

Jessica R Baxter
Examiner
Art Unit 3731

[Signature]
ANH TUAN T. NGUYEN
PRIMARY EXAMINER

11/11/04